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### **REMARKS**

This response is intended as a full and complete response to the non-final Office Action mailed on September 8, 2005. In the Office Action, the Examiner notes that claims 1-21, 27-49, 55-77, 83 and 84 are pending and rejected. By this response, Applicant has amended claims 1, 27, 29, 55, 57 and 83.

In view of both the amendments presented above and the following discussion, Applicant submits that all of the claims now pending in the application are non-obvious under 35 U.S.C. §103. Thus, Applicant believes that all of these claims are now in allowable form.

It is to be understood that Applicant, by amending the claims, does not acquiesce to the Examiner's characterizations of the art of record or to Applicant's subject matter recited in the pending claims. Further, Applicant is not acquiescing to the Examiner's statements as to the applicability of the art of record to the pending claims by filing the instant responsive amendments.

### **Amendments to the Claims**

By this response, Applicant has amended claims 1, 27, 29, 55, 57 and 83. The amendments to the claims are fully supported by the Specification. For example, the amendments to the claims are supported at least by pages 70-86 of the Specification.

Thus, no new matter has been added, and the Examiner is respectfully requested to enter the amendments.

### **35 U.S.C. §103 Rejection of Claims 1-4, 6-8, 10, 12-14, 16, 19-21, 27-32, 34-35, 38, 40-42, 44, 47-49, 55, 57-60, 62-64, 66, 68-70, 72, 75-77 and 83**

The Examiner has rejected claims 1-4, 6-8, 10, 12-14, 16, 19-21, 27-32, 34-35, 38, 40-42, 44, 47-49, 55, 57-60, 62-64, 66, 68-70, 72, 75-77, and 83 as being unpatentable under the provisions of 35 U.S.C. §103(a) over U.S. Patent 6,553,178-B2 to Abecassis (hereinafter "Abecassis") in view of U.S. Patent 5,754,938 to Herz (hereinafter "Herz"). Applicant respectfully traverses the rejection.

### **Claims 1, 29 and 57**

To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. The Abecassis and Herz

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references, alone or in combination, fail to teach or suggest all of the limitations recited in claim 1, and thus fail to teach or suggest the Applicant's invention as a whole.

Specifically, the Abecassis and Hertz references, singly or in combination, fail to teach or suggest at least the "pausing the video program upon detecting the receiving of the initiating portion of the audio communications event" as recited in claim 1 as amended.

The Abecassis reference discloses an advertisement subsidized video-on-demand system in which a user of the system may accept a communication during the use of the system and, in response to the acceptance of the communication, cause a transmission from a video server to be paused. Specifically, the Abecassis reference discloses (emphasis added below):

"A video and communication system for integrating the retrieval of a video and a communication comprises for example: i) retrieving means for retrieving a video from a video provider or from a storing means storing said video; ii) communicating means for receiving a communication; iii) accepting means for accepting said communication; iv) terminating means for terminating said communication; v) pausing means, responsive to said accepting means, for automatically pausing said retrieving; vi) resuming means, responsive to said terminating means, for resuming said retrieving; vii) transmitting means, responsive to said retrieving means, for transmitting to a viewing system; and viii) preferencing means for establishing video content preferences." (column 51, lines 25-39)

Abecassis also discloses (emphasis added below):

"If the viewer accepts the call 1311, RAViT initiates routines 1321-1323 to cause that the transmission of the video to the display is paused 1324. Viewer acceptance of the communication may include, for example, picking up a receiver, pressing a key on a remote control device, a voice command, or directly touching an icon on a screen either in a remote control device or on the display itself. Thus, a single viewer action or command 1311 both accepts the call and pauses the video 1324." (column 52, lines 18-27)

Thus, the pausing means of Abecassis is responsive to the accepting means, which accepts the communication received by the communicating means, and therefore only upon acceptance is there any pausing of content. By contrast, the claimed invention pauses a video program upon the detection of the receiving of an initiating portion of an audio communications event.

The Examiner alleges (emphasis added below):

"Applicant argues that the pausing means of Abecassis is

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responsive to the accepting means which accepts the communication received by the communication means and therefore only after acceptance is there any pausing of content. By contrast the claimed pauses a video program in response to the dictation of the receiving of an audio portion of a communications event (amendment page 16).

Regarding applicants argument, the independent claims merely require that the video program be paused in response to detection of receiving the audio portion of the communications event during the video program presentation. The claim is silent as to when the pause occurs, whether it is immediately in response to receipt of the audio portion, if it is at some time later, or if it is at the discretion of the user. Thus the broadest possible reasonable interpretation of the claim language does not preclude pausing the video at a portion of time designated by the user after the audio portion of the communications event has been received.

The communications event in Abecassis begins when a user accepts a request to begin an incoming phone call, or videoconference (Figure 13, step 1311), though the audio portion of the signal is routed to the display prior to the event beginning (column 52, lines 13-1 B). The software of Abecassis then automatically pauses the program upon detection of a user picking up a receiver, or pressing a button thus beginning the communications event (column 53, lines 18-26), an indication of the communications event is then displayed onscreen whether it is caller ID and caller information, paging information or video information (column 52, lines 43-65)." (Pages 2-3 of the 9/8/2005 Office Action)

However, the Applicant respectfully submits that the Examiner's interpretation of the phrase "in response to" distorts the commonly understood meaning of the claim language as previously presented. Nevertheless, claim 1 has been amended to clarify the meaning of the claim language and to remove any confusion as to possible interpretations of the claim language. In particular, claim 1 has been amended to recite that the pausing of the video program is "upon detecting the receiving of the initiating portion of the audio communications event." Thus, since the Abecassis reference only discloses pausing upon accepting a communication, the Abecassis reference does not teach or suggest pausing the video program upon detecting the receiving of the initiating portion of the audio communications event.

Furthermore, the Herz reference does not bridge the substantial gap between the Abecassis reference and Applicant's invention. The Herz reference "relates to customized electronic identification of desirable objects, such as news articles, in an electronic media environment" (Abstract). However, the Herz reference also does not

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teach or suggest the "pausing the video program upon detecting the receiving of the initiating portion of the audio communications event".

The combination of the Abecassis and Herz references therefore fails to teach or suggest Applicant's invention as a whole.

As such, Applicant submits that independent claim 1 fully satisfies the requirements of 35 U.S.C. §103 and is patentable thereunder. Furthermore, independent claims 29 and 57 have substantially similar relevant limitations as those discussed above in regards to claim 1. Therefore, independent claims 29 and 57 also fully satisfy the requirements of 35 U.S.C. §103 and are patentable thereunder. Additionally, claims 2-4, 6-8, 12-14, 16, 19-21, 29-32, 34-35, 38, 40-42, 44, 47-49, 57-60, 62-64, 66, 68-70, 72, and 75-77 depend, directly or indirectly, from independent claims 1, 29, and 57, and recite additional limitations thereof. As such, these dependent claims also fully satisfy the requirements of 35 U.S.C. §103 and are patentable thereunder.

Therefore, Applicant respectfully requests that the Examiner's rejection be withdrawn.

Claims 27, 55 and 83

Regarding claim 27, the Abecassis and Hertz references, singly or in combination, fail to teach or suggest at least "converting, during the telephone call, an audio portion of the telephone call to corresponding text; and displaying, during the telephone call, the corresponding text with the video program," as recited in the claim as amended.

As the Examiner acknowledges, "Abecassis fails to disclose converting an audio portion of the communications event to text for display with the video program" (page 12 of the 9/8/05 Office Action).

Moreover, Applicant respectfully submits that Abecassis also fails to teach or suggest the "displaying, during the telephone call, the corresponding text with the video program" as recited in the claim. Abecassis discloses (emphasis added below):

"FIG. 14B is an illustration of a display screen following viewer acceptance of the communication. Upon the pausing of the video, a last frame of the video image is reduced to an icon 1441. In the balance of the screen 1440, the videophone communication is displayed on a window 1451. Data 1452 associated with the communication is also displayed. In

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this example, the communication also comprises an integrated video transmission 1461 which is also displayed contemporaneously with the videophone transmission 1451." (column 54, lines 21-30)

Thus, Abecassis only discloses displaying a videophone communication, data associated with the communication, and an integrated video transmission.

Furthermore, in Figure 14B, it is shown that the data associated with the communication is the name "JENN". Therefore, Abecassis does not disclose displaying, during the telephone call, text which is converted from audio of the telephone call.

Incidentally, the Applicant respectfully notes that the Abecassis reference does not teach displaying "any other relevant data" as alleged by the Examiner on page 6 of the 9/8/2005 Office Action, but rather only discloses displaying data associated with the communication.

The Examiner then relies on the Herz reference to bridge the substantial gap between the Abecassis reference and the claimed invention. However, the Herz reference fails to bridge this gap. The Herz reference does not teach the "converting, during the telephone call, an audio portion of the telephone call to corresponding text." The Examiner alleges (emphasis added below):

"Applicant argues that Herz does not teach converting an audio portion of the telephone call to corresponding text and audio to text conversion of real time telephone calls during viewing of a video program (Amendment page 22)

Regarding applicants argument, the examiner notes that the claim requires conversion of real time telephone calls, not the conversion of audio to text conversion in real time as argued by the applicant. A telephone call occurs in real-time, likewise the recording of a telephone call occurs in real time, as both events occur while the telephone call is on going. Thus the claim requires audio to text conversion of real-time telephone calls which occur during viewing of a video program. Abecassis is relied upon to teach receiving a telephone call which occurs in real time while watching a video program, and storing the voice mail. Herz discloses audio to text conversion of voice mails and alerting a user when a new message is received. Therefore, it would have been obvious to one skilled in the art at the time of invention to modify Abecassis to utilize the voice to text conversion and alerting feature of Herz for the advantage of alerting a user when a new voice mail message is received without interrupting the display of the program." (Pages 5-6 of the 9/8/05 Office Action)

Thus, the Examiner alleges that the language of claim 27, as previously presented, recites conversion of real-time telephone calls, not real-time audio to text conversion of

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telephone calls. However, the Applicant respectfully submits that the Examiner has distorted the commonly understood meaning of the previously presented claim language. Nevertheless, the Applicant has amended claim 27 to clarify the meaning of the claim language. Thus, claim 27, as amended, recites "converting, during the telephone call, an audio portion of the telephone call to corresponding text." Therefore, it is now clear that the Herz reference does not teach the applicant's invention as recited in claim 27, because the Herz reference does not teach or suggest converting audio portion of a telephone call during the telephone call.

Instead, the Herz reference discloses (emphasis added below):

"These users need an e-mail filter, which automatically processes the messages received. The necessary processing includes a determination of the action to be taken with each message, including, but not limited to: filing the message, notifying the user of receipt of a high priority message, automatically responding to a message. The e-mail filter system must not require too great an investment on the part of the user to learn and use, and the user must have confidence in the appropriateness of the actions automatically taken by the system. The same filter may be applied to voice mail messages or facsimile messages that have been converted into electronically stored text, whether automatically or at the user's request, via the use of well-known techniques for speech recognition or optical character recognition." (column 61, line 51 to column 62, line 6)

Thus, the Herz reference only discloses voice mail messages which have been converted to text. However, the Herz reference does not teach or suggest that the voice mail messages are converted to text while the voice mail messages are being recorded. By contrast, the claimed invention teaches audio of a telephone call to text during the telephone call.

Furthermore, Applicant respectfully submits that the Herz reference also fails to teach or suggest the "displaying, during the telephone call, the corresponding text with the video program" as recited in the claim. The Examiner alleges (emphasis added below):

"Applicant argues that Abecassis does not disclose displaying the corresponding converted text along with the video (amendment page 21).

Regarding applicants argument, Abecassis discloses that the audio video and any other relevant data may appear on the display (column 52, lines 13-17). Herz is relied upon to display converted text (column 62,

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lines 1-40, converted text is forwarded to the user/user's secretary after it is passed through the filter)." (page 6 of the 9/8/05 Office Action)

Thus, the Examiner alleges that the disclosure by the Herz reference of forwarding of a message to a users secretary teaches the previously claimed "displaying the corresponding text with the video program". However, the applicant submits that forwarding a message to a users secretary does not teach displaying text with the video program. That is, there is no teaching that the secretary displays the text with the video program. Nevertheless, the Applicant has amended the claim to clarify the claim language, by reciting "displaying, during the telephone call, the corresponding text with the video program." Thus, as amended, the claim recites that the text is displayed during the telephone call and with the video program. The Herz reference does not teach or suggest displaying the converted text of the voice mail message while the voice mail message is being recorded.

Thus, the combination of the Abecassis and Herz references fails to teach or suggest Applicant's invention as a whole.

As such, Applicant submits that independent claim 27 satisfies the requirements of 35 U.S.C. §103 and is patentable thereunder. Furthermore, independent claims 55 and 83 have substantially similar relevant limitations as those discussed above in regards to claim 27. Therefore, independent claims 55 and 83 also fully satisfy the requirements of 35 U.S.C. §103 and are patentable thereunder. Additionally, claim 28 depends directly from independent claim 27 and recites additional limitations thereof. As such, claim 28 also fully satisfies the requirements of 35 U.S.C. §103 and is patentable thereunder.

Therefore, Applicant respectfully requests that the Examiner's rejection be withdrawn.

### **35 U.S.C. §103 Rejection of Claims 5, 33 and 61**

The Examiner has rejected claims 5, 33 and 61 under 35 U.S.C. §103(a) as being unpatentable over Abecassis in view of Herz in further view of Statutory Invention Registration H1714 to Partridge (hereinafter "Partridge"). Applicant respectfully traverses the rejection.

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Claims 5, 33 and 61 depend directly or indirectly from independent claims 1, 29 and 57. Moreover, for at least the reasons discussed above, the Abecassis and Herz references fail to teach or suggest the Applicant's invention as recited in claims 1, 29 and 57. Accordingly, any attempted combination of the Abecassis and Herz references with any other additional references, in a rejection against the dependent claims, would still result in a gap in the combined teachings in regards to the independent claims. As such, Applicants submit that depending claims 5, 33 and 61 are patentable under 35 U.S.C. §103.

Therefore, Applicant respectfully requests that the Examiner's rejection be withdrawn.

**35 U.S.C. §103 Rejection of Claims 11, 39 and 67**

The Examiner has rejected claims 11, 39 and 67 under 35 U.S.C. §103(a) as being unpatentable over Abecassis in view of Herz in further view of The Publisher's Page article (hereinafter "Publisher's Page"). Applicant respectfully traverses the rejection.

Claims 11, 39 and 67 depend directly or indirectly from independent claims 1, 29 and 57. Moreover, for at least the reasons discussed above, the Abecassis and Herz references fail to teach or suggest Applicant's invention as recited in claims 1, 29 and 57. Accordingly, any attempted combination of the Abecassis and Herz references with any other additional references, in a rejection against the dependent claims, would still result in a gap in the combined teachings in regards to the independent claims. As such, Applicants submit that depending claims 11, 39 and 67 are patentable under 35 U.S.C. §103.

Therefore, Applicant respectfully requests that the Examiner's rejection be withdrawn.

**35 U.S.C. §103 Rejection of Claims 9, 36, 37 and 65**

The Examiner has rejected claims 9, 36, 37, and 65 under 35 U.S.C. §103(a) as being unpatentable over Abecassis in view of Herz in further view of U.S. Patent 5,715,315 to Handelman (hereinafter "Handelman"). Applicant respectfully traverses the rejection.



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Claims 9, 36, 37 and 65 depend directly or indirectly from independent claims 1, 29 and 57. Moreover, for at least the reasons discussed above, the Abecassis and Herz references fail to teach or suggest Applicant's invention as recited in claims 1, 29 and 57. Accordingly, any attempted combination of the Abecassis and Herz references with any other additional references, in a rejection against the dependent claims, would still result in a gap in the combined teachings in regards to the independent claims. As such, Applicants submit that depending claims 9, 36, 37 and 65 are patentable under 35 U.S.C. §103.

Therefore, Applicant respectfully requests that the Examiner's rejection be withdrawn.

**35 U.S.C. §103 Rejection of Claims 15, 17, 43, 45, 71, and 73**

The Examiner has rejected claims 15, 17, 43, 45, 71 and 73 under 35 U.S.C. §103(a) as being unpatentable over Abecassis in view of Herz in further view of U.S. Patent 5,808,662 to Kinney (hereinafter "Kinney"). Applicant respectfully traverses the rejection.

Claims 15, 17, 43, 45, 71 and 73 depend directly or indirectly from independent claims 1, 29 and 57. Moreover, for at least the reasons discussed above, the Abecassis and Herz references fail to teach or suggest Applicant's invention as recited in claims 1, 29 and 57. Accordingly, any attempted combination of the Abecassis and Herz references with any other additional references, in a rejection against the dependent claims, would still result in a gap in the combined teachings in regards to the independent claims. As such, Applicants submit that depending claims 15, 17, 43, 45, 71 and 73 are patentable under 35 U.S.C. §103.

Therefore, Applicant respectfully requests that the Examiner's rejection be withdrawn.

**35 U.S.C. §103 Rejection of Claims 18, 46 and 74**

The Examiner has rejected claims 18, 46 and 74 under 35 U.S.C. §103(a) as being unpatentable over Abecassis in view of Herz in further view of U.S. Patent 6,480,667 to O'Connor (hereinafter "O'Connor"). Applicant respectfully traverses the rejection.

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Claims 18, 46 and 74 depend directly or indirectly from independent claims 1, 29 and 57. Moreover, for at least the reasons discussed above, the Abecassis and Herz references fail to teach or suggest Applicant's invention as recited in claims 1, 29 and 57. Accordingly, any attempted combination of the Abecassis and Herz references with any other additional references, in a rejection against the dependent claims, would still result in a gap in the combined teachings in regards to the independent claims. As such, Applicants submit that depending claims 18, 46 and 74 are patentable under 35 U.S.C. §103.

Therefore, Applicant respectfully requests that the Examiner's rejection be withdrawn.

**35 U.S.C. §103 Rejection of Claims 28, 56 and 84**

The Examiner has rejected claims 28, 56 and 84 under 35 U.S.C. §103(a) as being unpatentable over Abecassis in view of Herz in further view of U.S. Patent 6,006,257 to Slezak (hereinafter "Slezak"). Applicant respectfully traverses the rejection.

Claims 28, 56 and 84 depend directly or indirectly from independent claims 27, 55 and 83. Moreover, for at least the reasons discussed above, the Abecassis and Herz references fail to teach or suggest Applicant's invention as recited in claims 27, 55 and 83. Accordingly, any attempted combination of the Abecassis and Herz references with any other additional references, in a rejection against the dependent claims, would still result in a gap in the combined teachings in regards to the independent claims. As such, Applicants submit that depending claims 28, 56 and 84 are patentable under 35 U.S.C. §103.

Therefore, Applicant respectfully requests that the Examiner's rejection be withdrawn.

**CONCLUSION**

Thus, Applicant submits that all of the claims presently in the application are non-obvious under 35 U.S.C. §103. Accordingly, both reconsideration of this application and its swift passage to issue are earnestly solicited.

If, however, the Examiner believes that there are any unresolved issues requiring adverse final action in any of the claims now pending in the application, it is requested

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that the Examiner telephone Stephen Guzzi, at (732) 383-1405, or Eamon J. Wall, at (732) 530-9404, so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,

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